

REMARKS

By this amendment, Applicant amends claims 1, 9, and 12, and adds new claims 15-21. Claims 1-3 and 7-21 are now pending in this application.

In the Office Action,<sup>1</sup> the Examiner rejected claims 1-3 and 7-14 under 35 U.S.C. § 103(a) as being unpatentable over Kominek et al. (U.S. Patent No. 7,213,027) in view of Greenberg et al. (WO 00/39657). Applicant respectfully traverses the rejection.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

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<sup>1</sup> The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Final Office Action.

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Claim 1 recites a method that, among other steps, "in response to . . . receipt of . . . [an] identifier [of a second computer], **format[s] a coupon according to a specification of the second computer** and transmit[s] the coupon to the second computer" (emphasis added).

Kominek discloses a concept called "speak-throughs," which the Office Action has cited. See page 3. In particular, regarding "speak-throughs," Kominek discloses:

In the advertising context, "Speak-throughs" are requests to deliver more detailed information upon presentation of an advertisement. Advantageously, speak-throughs apply not only to speech interface, but also to both the WAP and WWW. For the WAP, speech and text can be considered for a speak-through while clicking on a banner to find out more on an ad would be a speak-through on the WWW. One embodiment of a speak-through on a voice interaction is to point the customer to a website address or a phone number. In alternative embodiments, speak-throughs collect an email address or a custom phone number to provide to the advertiser to send more relevant information to the customer. With a WWW interface, speak throughs may include using an outside source to manage and audit customer information. Advertising subsystem 120 may also provide targeted "banner" advertisements to users, chosen based on a utility function appropriate to the domain (e.g., WWW interface).

Col. 32, lines 4-20 (emphasis added).

As set forth above, in the Kominek system, a "speak-through" is a request to deliver more detailed information upon presentation of an advertisement. In particular, a "speak-through" can collect a customer's email address or phone number for the advertiser, which can then send information to the customer. Collecting a customer's email address or phone number, however, does not constitute or suggest that, "**in response to . . . receipt of . . . [an] identifier [of a second computer], a coupon [is formatted] according to a specification of the second computer and transmit[ed] . . . to the second computer,**" as recited in claim 1 (emphasis added).

Greenberg does not compensate for the deficiencies of Kominek. Greenberg concerns a "system and method for distributing and redeeming electronic coupons. Abstract. According to the Greenberg system and method, "[a]ll data in the database 24, including data associated with use and redemption of the coupon (e.g., menu data, the coupon text, redemption data, etc.) is electronically transmitted over a cellular network to each cellular telephone 30, such as in a data packet." Page 7, lines 7-10. Although the Greenberg system and method electronically transmits a coupon over a cellular network, the transmission that occurs does not include or suggest that "**in response to . . . receipt of . . . [an] identifier [of a second computer], a coupon [is formatted] according to a specification of the second computer and transmit[ed] . . . to the second computer,**" as recited in claim 1.

For at least the above reasons, Kominek and Greenberg, taken individually or in combination, do not teach or suggest each and every element of claim 1. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the

art to modify the disclosures thereof to achieve the claimed combination. Accordingly, claim 1 is not obvious in view of the cited references.

Independent claims 9 and 12, while of a different scope from claim 1 and each other, include recitations of a similar scope as those discussed above in connection with claim 1. Accordingly, the rejection of independent claims 9 and 12 should be withdrawn for at least the above reasons. Furthermore, claims 2, 3, 7, 8, 10, 11, 13, and 14 are allowable at least due to their dependence from allowable independent claims 1, 9, and 12. Therefore, for at least these reasons, the Examiner should withdraw the rejection of claims 1-3 and 7-14 under 35 U.S.C. § 103(a).

New claims 15-20 depend from independent claims 1, 9, and 12, and are allowable over the cited references at least due to their dependence. New independent claim 21, although of a different scope from the other independent claims, includes similar recitations as those discussed above and is therefore allowable for at least the reasons that were discussed in connection with the independent claims.

**CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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